

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of	:	Customer Number: 52021
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Christopher BERGH et al.	:	Confirmation Number: 1521
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Application No.: 09/575,283	:	Group Art Unit: 3624
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Filed: May 22, 2000	:	Examiner: J. Loftis
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Appeal No. 2011-000757	:	
	:	
For: CUSTOMER LEAD MANAGEMENT SYSTEM	:	

**REQUEST FOR REHEARING UNDER 37 C.F.R. §§ 41.50(b), 41.52(a)**

Mail Stop Appeal Brief - Patents  
Commissioner For Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This Request for Rehearing is submitted under 37 C.F.R. § 41.50(b) in response to the Decision on Appeal dated May 31, 2012 (hereinafter the Decision). This Request for Rehearing is timely filed within the two month time period for reply set forth under 37 C.F.R. § 41.52(a)(1).

Appellants respectfully submit that in the Decision, the Honorable Board either misapprehended and/or overlooked certain arguments presented by Appellants in the Appeal Brief of May 10, 2010, and in the Reply Brief of August 11, 2010. Appellants will specifically identify these particular points below.

**REMARKS**

On pages 9 and 10 of the Appeal Brief, Appellants presented arguments that "Anderson does not teach that a plurality of rules includes global rules and user specific rules." In the last full paragraph on page 6 of the Decision, the Board presented the following new claim constructions:

We construe global rules to be those such as is disclosed in Anderson as prospect demographics rules which use independent explanatory variables and thus are global in nature. We further construe specific rules as the disclosed dependent, business variables in Anderson which use historical data collected through past marketing campaigns. (emphasis added)

These claim constructions are not consistent with how the Examiner interpreted the language of the claims. For example, referring to page 11 of the Examiner's Answer, the Examiner asserted the "[w]hile the rules may be labeled as 'global' and 'user specific', these are simply labels that are not given weight" (emphasis added). Thus, the Examiner found no difference between the two claimed rules, which is very different from how the Board has treated the claim language.

The Board has previously held that a new claim construction constitutes a new grounds of rejection, Ex parte Agapi, Appeal No. 2009-005273 (non precedential) ("Appellants have not had a fair opportunity to argue the issues with respect to our claim interpretation nor has the Examiner had the opportunity to consider the claimed invention as interpreted by us."). Therefore, to the extent that the Board maintains the present rejection of the claims under 35 U.S.C. § 103, Appellants respectfully request that this rejection be designated a new grounds pursuant to 37 C.F.R. § 41.50(b).

Not only has the Board presented new grounds of rejection, the Board's newly-presented claim constructions include at least one error. Specifically, while the Board construed "global rules" and "specific rules," the claim limitations at issue refer to "global rules" and "user specific rules." The notion that the rules are specific to a user is completely absent from the Board's claim construction.

Each and every word in a claim must be construed to have meaning. Exxon Chem. Patents, Inc. v. Lubrizol Corp., 64 F.3d 1553, 1557 (Fed.Cir.1995). However, the Board's claim construction has omitted "user" within the claimed "user specific rules." "The protocol of giving claims their broadest reasonable interpretation during examination does not include giving claims a legally incorrect interpretation." In re Skvorecz, 580 F.3d 1262 (Fed. Cir. 2009). Appellants respectfully submit that the Board's analysis relies upon a legally incorrect interpretation, which constitutes reversible error.

In the paragraph spanning pages 6 and 7 of the Decision, the Board further asserted the following:

We further do not find persuasive Appellants' argument that the "relationship between a product and a set of customers [occurs] *before* a user of the system is involved" (Appeal Br. 10), because there is nothing in the claim that requires sequencing between the rules calculation and *when* the users employs them. (emphasis in original)

Appellants respectfully submit that the Board has misapprehended Appellants' arguments. The sentence immediately following the sentence cited by the Board is "[c]laim 29 specifically calls for the rules to determine an action with respect to the users, which is not suggested by Anderson." Appellants were contrasting the teachings of Anderson with the

limitations at issue. As cited by the Board, the ordinary meaning of a rule is "a prescribed guide for conduct or action." However, the teachings of Anderson refer to describing a relationship between a product and a set of customers. As claimed, the plurality of rules (i.e., the global rules and the user specific rules "determin[e] at least one action of the lead processing system with respect to the users." As again emphasized on page 2 of the Reply Brief, the "so called rules" of Anderson do govern an action (or conduct) of the leading processing system with respect to the users.

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On pages 10 and 11 of the Appeal Brief, Appellants presented arguments that "Griggs does not teach receiving feedback from at least one of the users, the feedback indicating whether the lead should be accepted, rejected or forwarded to another one of the plurality of users." In the last full paragraph on page 7 of the Decision, the Board presented the following new analysis:

We disagree with Appellants because we find that the determination of whether a lead is hot or cold is a rating. As such, each rating has intrinsic value as a directive of how valuable the lead is, and using common sense a person with ordinary skill in the art would understand that if a lead was marked as cold it should not be acted upon nor passed on, and vice versa. We find this given that Griggs discloses assigning each lead to the appropriate salesperson or channel partner (FF 7). Thus, a viable lead would be assigned/routed until it was acted on. The application of common sense may control the combining of references.

There are four issues associated with the Board's analysis. First, the Board's reliance upon "common sense" is completely new. The Examiner did not rely upon "common sense" in the Examiner's Graham findings of fact regarding the scope and content of Griggs. Thus, the Board's analysis includes a new grounds of rejection to which Appellants have not had an

1 opportunity to respond. Therefore, to the extent that the Board maintains the present rejection of  
2 the claims under 35 U.S.C. § 103, Appellants respectfully request that this rejection be  
3 designated a new grounds pursuant to 37 C.F.R. § 41.50(b).

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5 Second, Appellants also note that Board's reliance upon "common sense" is unsupported  
6 by substantial evidence. The Examiner cites to no authority for the "facts" as to what one having  
7 ordinary skill in the art would consider "common sense" at the time of the sentence. Post KSR,  
8 the issue of using "common sense" in a rejection under 35 U.S.C. § 103 was addressed by the  
9 Federal Circuit within Perfect Web Tech. v. InfoUSA, 587 F.3d 1324 (Fed. Cir. 2009). In  
10 Perfect Web, the Federal Circuit affirmed a rejection under 35 U.S.C. § 103 that relied upon  
11 "common sense." After discussing KSR, the Federal Circuit presented the following analysis  
12 regarding use of "common sense" in an obviousness rejection:

13 Common sense has long been recognized to inform the analysis of  
14 obviousness if explained with sufficient reasoning. Our predecessor court stated in In  
15 re Bozek, an appeal from the Board of Patent Appeals and Interferences, that it was  
16 proper for a patent examiner to rely on "common knowledge and common sense of  
17 the person of ordinary skill in the art without any specific hint or suggestion in a  
18 particular reference." 416 F.2d 1385, 1390 (CCPA 1969) (quotation marks omitted).  
19 We later clarified that an examiner may not invoke "good common sense" to reject a  
20 patent application without some factual foundation, where "basic knowledge and  
21 common sense was not based on any evidence in the record." In re Zurko, 258 F.3d  
22 1379, 1383, 1385 (Fed. Cir. 2001). We explained that when the PTO rejects a patent  
23 for obviousness, it "must not only assure that the requisite findings are made, based  
24 on evidence of record, but must also explain the reasoning by which the findings are  
25 deemed to support the agency's conclusion." In re Lee, 277 F.3d 1338, 1344 (Fed.  
26 Cir. 2002).

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28 As discussed by the Federal Circuit, even before KSR, the case law has not precluded the  
29 use of "common sense" by the Patent Office in making obviousness rejections. However, the use  
30 of "common sense" must have a factual foundation. As will be discussed in more detail below,

the Patent Office's factual findings are reviewed to determine whether they are unsupported by substantial evidence. Here, the Board presents no evidence to support the Board's findings as to what would have been considered "common sense" to those skilled in the art at the time of the invention. Therefore, the Board's findings are unsupported by substantial evidence, and the Board's reliance upon these unsupported findings constitutes reversible error.

Third, the Board's finding that "a person with ordinary skill in the art would understand that if a lead was marked as cold it should not be acted upon nor passed on, and vice versa" contradicts the Examiner's own findings of fact. Referring to page 5 of the Examiner's Answer, the Examiner made the finding of fact that "[c]old leads are also sent to salespeople for follow up (page 3, paragraph 14)."<sup>1</sup> Therefore, not only is the Board's analysis newly-presented and unsupported by substantial evidence, the findings of fact made by the Examiner contradicts the Board's allegation of what is "common sense."

Fourth, the Board's analysis fails to consider the actual arguments made by Appellants. Specifically, as discussed on page 11 of the Appeal Brief, since all of the leads are sent to salespeople, the feedback cannot be indicative of "whether the lead should be accepted, rejected or forwarded to another one of the plurality of users." Put differently, Griggs teaches that no matter the rating (e.g., "hot" or "cold") the leads are forwarded. Therefore, these ratings do not indicate whether the lead should be accepted, rejected or forwarded to another one of the plurality of users, as claimed. Appellants respectfully submit that the Board has overlooked these arguments.

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<sup>1</sup> Griggs actually teaches "[m]onthly listings of cold leads also are sent to salespeople, and some choose to follow up on those as well."

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3 On pages 11 and 12 of the Appeal Brief, Appellants presented arguments that "Griggs  
4 does not teaching re-routing at least one customer lead, based on a plurality of rules and received  
5 feedback from the at least one a plurality of users to another one of the users." These separate  
6 arguments were not addressed in the Decision. Thus, the Board has overlooked these arguments.

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9 On pages 12-14 of the Appeal Brief, Appellants presented arguments regarding the  
10 Examiner's failure to factually support the Examiner's taking of "Official Notice." The Board's  
11 initial response to these arguments is found in the first full paragraph on page 8 of the Decision  
12 and reproduced below:

13 Finally, we find no error with the Examiner's taking of Official Notice to  
14 establish that it would have been obvious to one of ordinary skill in the art at the time of  
15 the invention to employ client-server based technology. (Answer 6). In conjunction with  
16 this finding, the Examiner further found that the taken Official Notice "enhances the  
17 system by providing centralized multi-user functionality" (Answer 6), further buttressing  
18 the Examiner's prima facie case.  
19

20 The Examiner has the initial burden to set forth the basis for any rejection so as to put  
21 Appellants on notice of the reasons why Appellants are not entitled to a patent on the claim  
22 scope that Appellants seek – the so-called "*prima facie* case." In re Oetiker, 977 F.2d 1443,  
23 1445 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472 (Fed. Cir. 1984). If the Examiner  
24 does not produce a *prima facie* case of unpatentability, then the rejection cannot be maintained,  
25 and Appellants are not obligated to respond. See In re Oetiker, supra ("If examination at the  
26 initial stage does not produce a *prima facie* case of unpatentability, then without more the

applicant is entitled to grant of the patent"). Only after a *prima facie* case of unpatentability does the burden shift to Appellants to rebut the *prima facie* case. See In re Kahn, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("[o]n appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness") (quoting In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

Turning to law regarding "substantial evidence," decisions of the Patent Office are reviewed in accordance with the standards of the Administrative Procedure Act. See Dickinson v. Zurko, 527 U.S. 150, 165 (1999) (applying the Administrative Procedure Act, 5 U.S.C. § 706, to appeals of PTO rulings). Thus, the Patent Office's factual findings are reviewed to determine whether they are unsupported by substantial evidence. See In re Gartside, 203 F.3d 1305, 1312 (Fed. Cir. 2000). Substantial evidence means "more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion." Richardson v. Perales, 402 U.S. 389, 401 (1971). "[T]he Board cannot simply reach conclusions based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings." In re Zurko, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). The failure of the Board to provide an administrative record showing the evidence by which findings of fact are based constitutes reversible error. In re Lee 277 F.3d 1338 (Fed. Cir. 2002). The underlying findings of facts supporting the legal conclusion of obviousness are reviewed for substantial evidence. In re Gartside, 203 F.3d at 1316.



In the Decision of Ex parte Frye, (Appeal No. 2009-006013) (Precedential), the Honorable Board stated:

The panel then reviews the obviousness rejection for error based upon the issues identified by appellant, and in light of the arguments and evidence produced thereon. *See Oetiker*, 977 F.2d at 1445 ("In reviewing the examiner's decision on appeal, the Board must necessarily weigh all of the evidence and argument.") (emphasis added); *see also* 37 C.F.R. § 41.37(c)(1)(vii) (appeal brief must include "the contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on"). Specifically, the Board reviews the particular finding(s) contested by an appellant anew in light of all the evidence and argument on that issue.

Therefore, a complete *de novo* review is to be performed on all issues that are raised by Appellants without deference to the positions taken by the Examiner.

A few of the key points listed above are as follows:

- 1) the Examiner has the burden of establishing a *prima facie* case of obviousness;
- 2) findings of fact by the Board must be supported by substantial evidence;
- 3) the burden does not shift to Appellants until a *prima facie* case has been made; and
- 4) the Board reviews all findings anew.

Based upon the case law discussed above, the Board cannot assume that the Examiner has made out a *prima facie* case of obviousness. Instead, the Board must view all of the evidence anew. Thus, once Appellants have identified an error as to the Examiner's analysis regarding claim 28 (i.e., the Examiner's findings are based upon conclusory statements unsupported by fact), the Board must then determine if the Examiner's findings are supported by substantial evidence. However, by the Examiner's own admission, the Examiner has not relied upon substantial evidence, but instead Official Notice. On this basis, a *prima facie* case of obviousness has not been made since the findings of fact relied upon by the Examiner are unsupported by substantial evidence. Therefore, since a *prima facie* case has not been made, the

burden does not shift to Appellants to respond. This is why M.P.E.P. § 2144.03 admonishes that the circumstances in which Official Notice can be taken "should be rare when an application is under final rejection" (emphasis added).

Reference is also made to the Board decision of Ex parte Yardley (Appeal 2009-001146) (non-precedential), which stated that "[t]he procedures setting forth the circumstances in which official notice may properly be taken do not recognize any basis for the taking of official notice of a legal conclusion." However, this is precisely what the Examiner did when asserting "Examiner takes official notice that it would have been obvious to one of ordinary skill in the art." In other words, the Examiner took official notice of the legal conclusion of obviousness.

Put differently, the Board appears to be taking the approach that once the Examiner takes "Official Notice" of a particular fact,<sup>2</sup> then Appellants are burdened with proving the Examiner is wrong. If this is the approach the Board is taking, then this approach directly conflicts with Federal Circuit law that requires (i) the Examiner has the initial burden of establish a prima facie case of unpatentability, (ii) findings of fact must be supported by substantial evidence; and (iii) the burden does not shift to Appellants until a prima facie case of unpatentability has been made. Official Notice does not constitute a finding of fact supported by substantial evidence.<sup>3</sup> Therefore, a prima facie case of patentability is not made when Official Notice is relied upon, and thus, the burden has not been shifted to Appellants to present contradicting evidence.

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<sup>2</sup> In this instance, the Examiner took official notice of more than just facts.

<sup>3</sup> If "Official Notice" was deemed substantial evidence and sufficient to establish a prima facie case, all any Examiner need do to establish a prima facie case of unpatentability is take Official Notice of the claimed limitations. If this was permissible, this tactic would, in essence, shift the burden of proof to Appellants without the Examiner having to cite a single piece of prior art. Such a result would be absurd but it is permissible based upon the Board's apparent interpretation regarding the taking of Official Notice.

Appellants need only request that the Examiner make a showing that the facts asserted are well-known and capable of instant and unquestionable demonstration of being well-known. This burden has yet to be met.

In the last full paragraph on page 8 of the Decision, the Board further asserted the following:

Rather, the test under our review here is whether Appellants have specifically pointed out the supposed errors in the Examiner's taking of Official Notice, "includ[ing] stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR § 1.111(b)." MPEP § 2144.03(C). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. In *re* Boon, 439 F.2d 724, 728 (CCPA 1971). That has not been done here. When an Appellant does not seasonably traverse a well-known statement during examination, the object of the well-known statement is taken to be admitted prior art. In *re* Chevenard, 139 F.2d 711 (CCPA 1943).

Notably, the Board relies upon the M.P.E.P. However, as admitted by the Patent Office,<sup>4</sup> "[t]he MPEP does not have the force of law or the force of the rules." Therefore, although it is appropriate to rely upon the law referenced by the M.P.E.P., the M.P.E.P. itself does not have any precedential value. Second, the Board relies upon 37 C.F.R. § 1.111(b). Citing to this rule is inappropriate since this particular rule applies to a reply to a "non-final Office Action," whereas the contents of an Appeal Brief are governed under 37 C.F.R. § 41.67. Thus, the requirements set out within 37 C.F.R. § 1.111(b) do not apply to an Appeal Brief.

The Board's citation to *In re Boon* is also notable in that the issue addressed by the CCPA was not of the Examiner taking Official Notice and Appellants' traversal thereof. Instead, the

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<sup>4</sup> See [http://www.uspto.gov/about/offices/patents/pep/mpep\\_staff.jsp](http://www.uspto.gov/about/offices/patents/pep/mpep_staff.jsp).

issue raised within In re Boon regarding the "use [by the Board] of facts judicially noticed." The CCPA also noted to allow "a bald challenge, with nothing more" to justify the reopening of prosecution "would effectively destroy any incentive on the part of the board to clarify or justify a position taken by an examiner through the artful use of facts judicially noticed." Thus, the ultimate issue raised within In re Boon is the sufficiency of the traversal needed to be presented by Appellants in order to establish that the Board raised a new grounds of rejection through the use of facts judicially noticed. Not only are the facts regarding use of "facts judicially noticed" within In re Book entirely different than in the present Application, the justification for requiring more than "a bald challenge" is not relevant in the present Application.

Additionally, the CCPA only required that "challenge to judicial notice by the board contain adequate information or argument so that *on its face* it creates a reasonable doubt regarding the circumstances justifying the judicial notice" (emphasis in original). The term "on its face," which was italicized by the CCPA, is legal shorthand for *prima facie*<sup>5</sup> and is presumed to be true unless it is disproved. Thus, the CCPA instituted a very low threshold for Appellants to overcome in order to successfully challenge the taking of judicial notice by the Board. To the extent that this requirement could be imported into the entirely different factual situation presented by the present Application, Appellants have presented arguments, which *on its face*, creates a reasonable doubt as to Official Notice taken by the Examiner.

Notwithstanding that Appellants' have met the burden set forth within In re Boon, Appellants note that In re Boon was decided well before Zurko and Piasecki, which respectively

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<sup>5</sup> Black's Law Dictionary, 1189 (6th ed. 1990) ("At first sight; on the first appearance, on the face of it; so far as can be judge from the first appearance, presumably, a fact presumed to be true unless disproved by some evidence to the contrary").

require that the Patent Office be bound by the Administrative Procedures Act (and thus, requiring that the Patent Office's decisions be based upon substantial evidence) and that Appellants have no burden to respond when the Examiner fails to set forth a *prima facie* case of unpatentability. As noted above, since the Examiner's findings regarding claim 29 were unsupported by substantial evidence, the Examiner has failed to establish a *prima facie* case. To the extent that the Board is relying upon some requirement, from In re Boon, which is inconsistent with either Zurko or Piasecki, this requirement has been implicitly overruled.

Finally, the Board's citation of In re Chevenard is inappropriate. As argued on page 4 of the Reply Brief, the Examiner's taking of Official Notice was first introduced in the appealed Final Office Action.<sup>6</sup> Thus, Appellants seasonably challenged the Examiner's taking of Official Notice at the first opportunity presented to Appellants (i.e., the Appeal Brief).

Appellants also note that In re Chevenard and In re Boon are court/agency review cases. At the time, the CCPA's case law created a presumption in favor of the PTO, and required an Appellant to show "clear error." In contrast, during intra-PTO proceedings, the presumption is in favor of the applicant, and the burden is on the PTO to support any adverse finding by substantial evidence. Thus, In re Chevenard and In re Boon are inapplicable to an intra-agency setting.

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<sup>6</sup> Compare page 5 of the Office Action dated November 18, 2008, with page 5 of the appealed Final Office Action dated July 9, 2009. The paragraph beginning "[f]urther, the combination of above listed references does not explicitly teach secondary lead management server ... Examiner takes official notice") is found in the Final Office Action but not in the prior non-final Office Action.

On pages 14 and 15 of the Appeal Brief, Appellants presented arguments that "[t]he examiner's official notice does not remedy the deficiencies of the alleged combination of Anderson, Griggs, and Netscape/Aurum." These separate arguments were not addressed in the Decision. Thus, the Board has overlooked these arguments.

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On pages 15 and 16 of the Appeal Brief, Appellants presented arguments that "Anderson does not teach rules that comprise attachment rules for determining additional information to be attached to leads prior to further routing of the lead." On page 9 of the Decision, the Board presented the following analysis:

We disagree with Appellants because nothing in the claim prohibits the additional information from being including at the source when the lead information is generated as taught by Anderson at column 8, lines 49-67 as found by the Examiner. (emphasis added)

Appellants respectfully disagree.

As recited in claim 29 (upon which claims 32 depends), the lead is routed based upon the plurality of rules, and as recited in claim 32, the rules include attachment rules. In order for the lead to be evaluated against the rules, the lead must already exist. However, claim 32 recites the attachment rules determine "additional information to be attached to the leads prior to further routing of the lead." Therefore, the "additional information" cannot already be attached to the lead at the time the attachment rule is evaluated since the "additional information" is to be attached (i.e., not yet attached). Therefore, the claims clearly and unambiguously prohibit the information from already being attached to the lead because such information is not "additional information to be attached to the leads."

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 090461, and please credit any excess fees to such deposit account.

Date: July 30, 2012

Respectfully submitted,

/Scott D. Paul/

Scott D. Paul

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CUSTOMER NUMBER 52021